

REMARKS

Reconsideration of the application is respectfully requested in view of the amendments and the remarks presented below. The amendments are supported by the application as filed and no new matter has been added by any of the amendments.

Amendments to the claims

New claims 23-26 are added to more particularly point out and distinctly claim the invention. The new claims are discussed in the remarks below.

Claims 18-22 are cancelled without prejudice.

Claim 11 is amended to state that it is dependent on claim 8 rather than claim 6. This is a correction of an obvious typographic error in order to provide antecedent basis for the "said step of generating a state signal."

Claim 15 is amended as discussed below in connection with the 35 USC 112, second paragraph rejection of that claim.

Claims 1-17 and 23-26 are now present in this application.

Amendments to the specification

The specification is amended at pages 5 and 27, as discussed below in connection with the objections to the drawings and specification.

Amendments to the drawings

Sheet 4 of the drawings (Figure 4) is amended. A replacement sheet no. 4 accompanies this paper and is discussed in the remarks in connection with the objection to the drawings.

Discussion

I. No Certified Copy of a Foreign Application Is Required

This application was filed as a continuation of PCT/GB00/03613, an international application filed abroad and published as WO 01/27722. PCT/GB00/03613 designated the United States. A copy of the face page of WO 01/27722 is enclosed at Tab A.

An international application designating the United States shall have the effect from its international filing date of a national application for patent regularly filed in the United States Patent and Trademark Office, except as otherwise provided in 35 U.S.C. 102(e). 35 U.S.C. § 363. A U.S. application may be filed as a continuation of such an international application. *See* 35 U.S.C. §§ 120 and 365(c).

“If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.” 35 U.S.C. § 365(c). However, “[i]f the international application was published by the International Bureau pursuant to PCT Article 21, then a certified copy would not normally be necessary.” M.P.E.P. § 1895.1

It is believed that the applicant need not provide a certified copy of the international application because this application was published by the International Bureau as WO 01/27722. The Examiner is respectfully requested to withdraw any requirement for a certified copy.

II. The Foreign Patent Documents and the Non-Patent Literature Provided with the Information Disclosure Statements Filed on March 14, 2003 and December 9, 2003 Should Have Been Considered by the Examiner

The Examiner declined to consider the foreign patent documents and non-patent literature publications that were submitted with the information disclosure statements filed on March 14, 2003 and December 9, 2003 (these are the 37 CFR 1.10 filing dates). The Examiner implied that legible copies were not supplied in accordance with 37 CFR 1.98(a)(2). The attached declaration of Suzanne Johnston establishes that the Patent and Trademark Office received these documents because 1) they were sent to the Office and 2) the Office affixed its stamp to the applicants' attorney's return receipt postcards in order to confirm the Office's receipt of these documents and the accompanying information disclosure statements.

The applicants are willing to supply replacement copies of the cited non-U.S. patent references, as a convenience to the Office, if the Office lost or defaced these documents. The

Office is requested to state whether it would like to receive replacement copies of the references that were enclosed with these information disclosure statements.

No 37 CFR 1.97(c) fee or statement is believed to be necessary for having the references considered, because the Office should have considered the ones originally sent.

The Examiner is requested to consider the foreign patent documents and the non-patent literature publications that were submitted with the two information disclosure statements in question and indicate the completion of his review by appropriately initialing the copies of the original forms 1449 (enclosed at Tabs C and D) and returning the same with the next office action.

III. The Objections to the Drawings Have Been Overcome

The Examiner objected to the drawings because the drawings did not contain reference numeral 202 mentioned in the specification but did contain reference numeral 803 that was not mentioned in the specification.

A replacement sheet for sheet 4 in the drawings is attached at Tab B in which the drawing of Figure 4 is corrected by changing reference numeral "203" to "202," in order to correct an obvious inadvertent error.

The specification is amended at page 27, line 28, to supply the inadvertently omitted reference to step 803.

The Examiner is respectfully requested to approve and enter these amendments. The objections to the drawings should then be withdrawn.

IV. The Objection to the Specification Has Been Overcome

The Examiner objected to the specification because it referred to an acronym well known in the art, "BIOS," without defining that acronym. The specification has been amended to state that "BIOS" stands for "Basic Input Output System" and therefore this objection should be withdrawn.

V. The Rejection of Claim 15 Under 35 USC 112, Second Paragraph, Should Be Withdrawn

Claim 15 was rejected as being indefinite because the “means” in the “said second memory means of said monitoring component” allegedly lacked antecedent basis. Claim 15 has been amended to delete the word “means.” The “second memory” has antecedent basis in claim 6, the independent claim from which it depends. The rejection of claim 15 under 35 USC 112, second paragraph, therefore should be withdrawn.

VI. The Rejection of Claims 6, 8, 10, 11, and 13 under 35 USC 102(e) Should Be Withdrawn

The Examiner rejected claims 6, 8, 10, 11, 13, 18-19, and 21-22 under 35 USC 102(e) as being anticipated by Vineyard, Jr., et al., U.S. Patent 6,727,920 B1.

Claims 18-19 and 21-22 have been cancelled without prejudice. Claim 6 is an independent claim and claims 8, 10, 11, and 13 each depends directly or indirectly from claim 6.

Claim 6

Claim 6 is directed to:

[a] method of activating a computing entity comprising a computer platform having a first data processor and a first memory and a monitoring component having a second data processor and a second memory, into an operational state of a plurality of pre-configured operational states into which said computer platform can be activated, said method comprising the steps of:

selecting a state of said plurality of pre-configured operational states to activate for said computer platform;

activating said selected state for said computer platform according to a set of stored instructions;

wherein said monitoring component monitors activation of said selected state by recording data describing which of said plurality of pre-configured states is activated.

Vineyard, Jr., et al. teach providing mechanisms for allowing an operating system to be selected or chosen automatically at system boot for a computer system with a number of alternative operating systems. Vineyard, Jr., et al. teach the selection of an operating system, but

not the measurement of an operating system by a monitoring component to determine whether a pre-configured state has been activated.

The Examiner states that all of these limitations are taught in Vineyard, Jr. et al. This has not been shown to be the case.

For example, the Examiner states that "a computing entity comprising a computer platform having a first data processor and a first memory and a monitoring component having a second data processor and a second memory, into an operational state of a plurality of pre-configured operational states into which said computer platform can be activated" is disclosed in Vineyard, Jr., et al. at "figure 3, column 4, lines 48-67, column 5, lines 1-67" and that the third step, "wherein said monitoring component monitors activation of said selected state by recording data describing which of said plurality of pre-configured states is activated," is disclosed at "column 6, lines 1-67." Applicants are unable to find a disclosure of these limitations in the referenced text and drawing.

It is noted that the Examiner cited two entire columns plus a portion of a third, which may indicate that the Examiner was unable to be more specific because of a lack of any disclosure of these limitations in the text of Vineyard, Jr., et al.

In general, the format of the Office Action is to quote a claim limitation, simply state that a reference teaches the limitation from a claim, and then cite a block of text in the reference. The Office Action provides no correlation of the claim limitations to what the reference actually teaches in terms of the language and reference numerals of the reference.

It is suggested that this procedure is not very helpful to the examination of this application, if only because it forces the applicants to guess at which components and steps the Examiner had in mind when citing blocks of text that describe many steps and components.

The reference to Figure 3 of Vineyard, Jr., et al. does not help because it certainly contains no teaching of the recited limitations. Figure 3 is merely a schematic that depicts "the interaction of an Operating System with computer components." Column 3, lines 54-55.

37 CFR 1.104(c)(2) provides that "[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a

reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. *The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified* [emphasis supplied].”

The Examiner is respectfully asked to “explain the pertinence” of Vineyard, Jr., et al. by identifying the specific disclosure in the specification of Vineyard, Jr., et al. of “a monitoring component having a second data processor and a second memory” that “monitors activation of said selected state by recording data describing which of said plurality of pre-configured states is activated.” Failing such identification, it is respectfully submitted that a *prima facie* case for rejection of claim 6 has not been established.

To anticipate a claim, the reference must teach every element of the claim and the elements in the reference must be arranged as required by the claim. M.P.E.P. § 2131. Vineyard, Jr., et al., does not teach or suggest at least the limitations quoted from claim 6. The Section 102(e) rejection of claim 6 over the Vineyard, Jr., et al., reference should be withdrawn for at least this reason.

Claims 8, 10, 11, and 13

Claims 8, 10, 11, and 13 each depend directly or indirectly from independent claim 6 and cannot be rejected as being anticipated by Vineyard, Jr., et al., at least by virtue of their dependency on that independent claim.

Furthermore, these claims contain additional limitations that do not appear to be disclosed in Vineyard, Jr., et al. As with the rejection of claim 6 due to alleged anticipation by Vineyard, Jr. et al., *the applicant must ask the Examiner to identify where the limitations added by claims 8, 10, 11, and 13 are disclosed in Vineyard, Jr. et al.*, preferably by more than a general correlation of a claim limitation to a large block of text.

Thus, the step of “generates a state signal in response to a signal input directly to said monitoring component by a user of said computing entity, said state signal indicating which said state said computer platform has entered” added by claim 8 is said to be taught somewhere in 67 lines of Vineyard, Jr., et al., the step of “generating a menu for selection of a said pre-configured

state from said plurality of pre-configured states” added by claim 10 is said to be taught somewhere in 65 lines of Vineyard, Jr., et al., the “step of generating a user menu displayed on a user interface for selection of a said pre-configured state from said plurality of pre-configured states, and said step of generating a state signal comprises generating a state signal in response to a user input accepted through said user interface” added by claim 11 is said to be taught somewhere in 65 lines of Vineyard, Jr., et al., and the limitation “wherein said step of selecting a state of said plurality of pre-configured operational states comprises receiving a selection message from a network connection, said selection message instructing a BIOS file of said computer platform to activate said computer platform into a selected state” added by claim 13 is said to be taught somewhere in 49 lines of Vineyard, Jr., et al.

Failing such identification, it is respectfully submitted that a *prima facie* case for rejection of claims 8, 10, 11, and 13 has not been established, even if claim 6 were not allowable over Vineyard, Jr. et al.

The Section 102(e) rejection of claims 6, 8, 10, 11, and 13 over the Vineyard, Jr., et al., reference should be withdrawn.

VII. The Rejection of Claims 1-4, 7, and 17 under 35 USC 103(a) Should Be Withdrawn

The Examiner rejected claims 1-4, 7, and 17 under 35 USC 103(a) as being unpatentable over Vineyard, Jr., et al., and further in view of Vrhel, et al., U.S. Patent 6,560,726 B1. This rejection should be withdrawn because neither Vineyard, Jr., et al. nor Vrhel, et al., singly or in combination, disclose the claimed subject matter.

Claim 1

Claim 1 is directed to:

[a] computing entity comprising:

[1] a computer platform comprising a plurality of physical and logical resources including a first data processor and a first memory;

[2] a monitoring component comprising a second data processor and a second memory;

[3] wherein, said computer platform is capable of operating in a plurality of different states, each said state utilizing a corresponding respective set of individual ones of said physical and logical resources;

[4] wherein said monitoring component operates to determine which of said plurality of states is the current operating state of said computer platform.

The Examiner stated that limitations [1]-[3] of claim 1 are taught by Vineyard, Jr., et al. with the exception of limitation [4], which is said to be a teaching of Vrhel, et al. The applicant respectfully disagrees.

With respect to claim 1, limitation [1], a computer platform, is arguably disclosed by Vineyard, Jr. et al. Limitations [2], "a monitoring component comprising a second data processor and a second memory," and [3], "wherein, said computer platform is capable of operating in a plurality of different states, each said state utilizing a corresponding respective set of individual ones of said physical and logical resources" do not appear to be disclosed although they are said to be found in Vineyard, Jr., et al. at column 4, lines 48-67 to column 5, lines 1-30 and column 5, lines 30-67, respectively. With respect to limitation [3], for example, Vineyard, Jr., et al. discuss a computer that has an interface for permitting selection of a default operating system from a list of operating systems available. Assuming an operating system is comparable to a state (which it is not – see the definition of "state" in the specification of the application at page 24, line 23- page 25, line 6), nothing is stated about each operating system "utilizing a corresponding respective set of individual ones of said physical and logical resources" and the Office Action does not state where in column 5, lines 30-67 of Vineyard, Jr. et al. it is to be found.

With respect to limitation [4], "wherein said monitoring component operates to determine which of said plurality of states is the current operating state of said computer platform," the 87 lines of text of Vrhel, et al. referenced in the Office Action are generally directed to a discussion of a "monitoring system" for a computer system that "detects operating system boot failures and various types of operating system hang-ups." Col. 4, lines 44-45. The Examiner has located a reference with a so-called "monitoring system" for a computer system but has not identified

where in the 87 lines of text the “monitoring system” determines “which of said plurality of states is the current operating state of said computer platform.”

As noted above, the procedure of the Office Action generally is to simply state that a reference teaches a limitation from a claim (quoting the claim limitation) and then to cite to many lines of text in the reference without any discussion of which of the many components and steps disclosed in that text correspond to the claim limitation. The Office Action does not mention the specific components or steps taught by the reference that are alleged to correspond to the claimed limitation.

The Examiner is respectfully asked to identify the specific disclosures of the specifications of Vineyard, Jr., et al. and Vrhel, et al. that set forth the claimed limitations.

The Examiner is also requested, pursuant to MPEP 2144.03B and C, to state the basis for his finding in connection with the motivation that would inspire a person of ordinary skill in the art to “integrate the monitoring system of Vrhel, et al. with the teachings of Vineyard, Jr., et al. to provide a multiple state computing entity that monitors its states.” The stated motivation, “[o]ne of ordinary skill in the art would have been motivated to do so because it was well known in the art to monitor the current state of a computer” is a general and unsupported assertion that appears to be based on the applicants’ disclosure.

Until this is accomplished, the Office Action cannot be said to have cited references that teach or suggest the limitations of claim 1, either singly or in combination. The rejection of claim 1 under 35 USC 103(a) should be withdrawn.

Claims 2-4, 7, and 17

Claims 2-4 depend from independent claim 1, claim 7 depends from independent claim 6, and claim 17 depends from independent claim 6. The rejections of these claims under 35 USC 103(a) are all based on Vineyard, Jr. et al. in view of Vrhel, et al.

Claims 2-4 are allowable as dependent claims in view of the allowability of claim 1 over these references and without considering the additional limitations added to the limitations of claim 1 by these references. Furthermore, the rejection of these claims also was accomplished

by quoting the limitation added by the claim, and then citing to large blocks of text¹ in Vineyard, Jr. et al. or Vrhel, et al. as teaching that limitation, but without identifying the specific step or component that corresponds to the limitation. *The Examiner is respectfully asked to identify the specific disclosures of the specifications of Vineyard, Jr., et al. and Vrhel, et al. that set forth the claimed limitations.*

Claims 7 and 17 are allowable because Vineyard, Jr., et al. was not shown to anticipate claim 6 and Vrhel, et al. is cited only for teaching the limitations added by claims 7 and 17. The combination of Vineyard, Jr., et al. and Vrhel, et al. does not make these claims unpatentable.

Furthermore, these claims also were addressed by quoting the limitation added by the claim, and then citing to large blocks of text² in Vrhel, et al. as teaching that limitation but without identifying the specific step or component that corresponds to the limitation. *The Examiner is respectfully asked to identify the specific disclosures of the specifications of Vrhel, et al. that set forth the claimed limitations.*

The Section 103(a) rejection of claims 1-4, 7, and 17 over Vineyard, Jr., et al. in view of Vrhel, et al. should be withdrawn.

VIII. The Rejection of Claim 5 under 35 USC 103(a) Should Be Withdrawn

The Examiner rejected claim 5 under 35 USC 103(a) as being unpatentable over Vineyard, Jr., et al. and Vrhel, et al. and further in view of Hannah, U.S. Patent 6,735,696 B1.

Claim 5 requires "wherein said computer platform comprises an internal firmware component configured to compute a digest date of a BIOS file data stored in a predetermined memory space occupied by a BIOS file of said computer platform."

Claim 5 depends from claim 1 and is allowable at least because that claim is allowable over Vineyard, Jr., et al. and Vrhel, et al. Hannah is cited only for the limitation added by claim 5.

The Section 103(a) rejection of claim 5 over Vineyard, Jr., et al. and Vrhel, et al. and further in view of Hannah should be withdrawn.

¹ Claim 2: Vineyard, Jr., et al., 49 lines; claim 3: Vrhel, et al., 87 lines, claim 4: Vineyard, Jr., et al., 49 lines.

² Claim 7: 87 lines, claim 17: 87 lines.

IX. The Rejection of Claim 9 under 35 USC 103(a) Should Be Withdrawn

The Examiner rejected claim 9 and 20 under 35 USC 103(a) as being unpatentable over Vineyard, Jr., et al.

Claim 20 has been cancelled without prejudice.

Claim 9 requires "wherein said set of stored instructions are stored in a BIOS file resident within said monitoring component."

Claim 9 depends from claim 6 and is allowable at least because that claim is allowable over Vineyard, Jr., et al.

The Section 103(a) rejection of claim 9 over Vineyard, Jr., et al. should be withdrawn.

X. The Rejection of Claim 12 under 35 USC 103(a) Should Be Withdrawn

The Examiner rejected claim 12 under 35 USC 103(a) as being unpatentable over Vineyard, Jr., et al. and Vrhel, et al. and further in view of Herzi, et al., U.S. Patent 6,353,885 B1.

Claim 12 requires "in which said step of selecting a state of said plurality of pre-configured operational states comprises receiving a selection signal from a smartcard device, said selection signal instructing a BIOS of said computer platform to activate the said computer platform into a selected state."

Claim 12 depends from claim 7 and thus from claim 6. It is allowable at least because that claim is allowable over Vineyard, Jr., et al. and Vrhel, et al. Herzi, et al. are cited only for the limitation added by claim 12.

The Section 103(a) rejection of claim 12 over Vineyard, Jr., et al. and Vrhel, et al. and further in view of Herzi, et al. should be withdrawn.

XI. The Rejection of Claims 14-15 under 35 USC 103(a) Should Be Withdrawn

The Examiner rejected claim 14-15 under 35 USC 103(a) as being unpatentable over Vineyard, Jr., et al., and further in view of Hannah.

Claim 14 requires "wherein said step of monitoring a selected state comprises: immediately before activating said computer platform, creating by means of a firmware

component a digest data of a first pre-allocated memory space occupied by a BIOS file of said computer platform;

writing said digest data to a second pre-allocated memory space to which only said firmware component has write access; and

said monitoring component reading said digest data from said second pre-allocated memory space.”

Claim 15 requires “wherein said step of monitoring said state into which said computer platform is activated comprises:

executing a firmware component to compute a digest data of a BIOS file of said computer platform;

writing said digest data to a predetermined location in said second memory of said monitoring component.”

Claims 14 and 15 each depends from claim 6. Each is allowable at least because that independent claim is allowable over Vineyard, Jr., et al. Hannah is cited only for the limitations added by claims 14 and 15.

The Section 103(a) rejection of claims 14 and 15 over Vineyard, Jr., et al. in view of Hannah should be withdrawn.

XII. The Rejection of Claim 16 under 35 USC 103(a) Should Be Withdrawn

The Examiner rejected claim 16 under 35 USC 103(a) as being unpatentable over Vineyard, Jr., et al., and further in view of Galasso, et al., U.S. Patent 6,148,387, and Hannah.

Claim 16 requires “wherein said step of activating selected state comprises:

at a memory location of said first memory, said location occupied by a BIOS file of said computer platform, storing an address of said monitoring component which transfers control of said first processor to said monitoring component;

storing in said monitoring component a set of native instructions which are accessible immediately after reset of said first processor, wherein said native instructions instruct said first processor to calculate a digest of said BIOS file and store said digest data in said second memory of said monitoring component; and

said monitoring component passing control of said activation process to said BIOS file,

once said digest data is stored in said second memory.”

Claim 16 depends from claim 6. It is allowable at least because that claim is allowable over Vineyard, Jr., et al. Galasso, et al. and Hannah are cited only for the limitation added by claim 16.

The Section 103(a) rejection of claim 16 over Vineyard, Jr., et al. and further in view of Galasso et al. and Hannah should be withdrawn.

New Claims 23-26

New claims 23-26 are method claims added to more particularly point out and distinctly claim the invention, particularly in regards to the storing of data generated when the computer platform was in a selected state for use later when the computer platform is in that state again. The new claims are supported by the specification of the application as filed. *See* specification at page 34, line 2, to page 37, line 11. No new matter has been added.

New claim 23 depends from claim 6 and is allowable at least because of its dependency. New claim 24 depends from claim 23 and is likewise allowable. New claim 25 is independent and claim 26 depends from claim 25. It is submitted that claims 25 and 26 are allowable over the references of record.

Allowable Subject Matter

Claims 1-17 are allowable because the rejections over Sections 102(e), 103(a), and 112 have been overcome as described above. The new claims are also allowable over the references of record. In addition, the various objections have been addressed and overcome.

In view of the above, the Applicant submits that the application is now in condition for allowance and respectfully urges the Examiner to pass this case to issue. The Examiner is respectfully invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

* * *

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely

filed with an appropriate petition to extend the time period pursuant to 37 CFR 1.136(a) or the correct petition fee, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and any additional petition fee due in connection therewith may be charged to deposit account no. 08-2025.

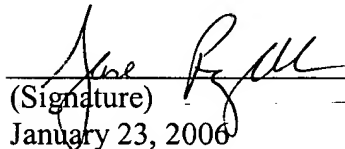
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January 23, 2006

(Date of Transmission)

Jane Penzell

(Name of Person Transmitting)

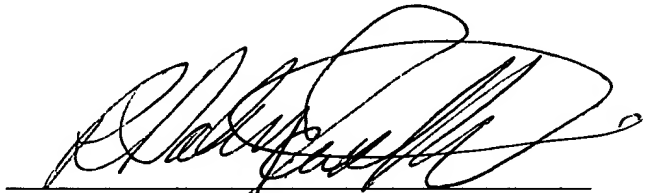


(Signature)

January 23, 2006

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Respectfully submitted,



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